IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: §	Group Art Unit: 2155
Boman Irani §	
§	Examiner: Dinh, Khanh Q.
Serial No.: 09/333,383 §	
§	Atty Dkt.: 5181-29600
Filed: June 18, 1999 §	
§	
For: System and Method for §	
Pushing Personalized §	
Content to Small Footprint §	
Devices §	

APPEAL BRIEF

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Sir/Madam:

Further to the Notice of Appeal filed December 8, 2003, Appellant presents this Appeal Brief. Appellant respectfully requests that this appeal be considered by the Board of Patent Appeals and Interferences.

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I. REAL PARTY IN INTEREST

The subject application is owned by Sun Microsystems, Inc., a corporation organized and existing under and by virtue of the laws of the State of Delaware, and having its principal place of business at 4150 Network Circle, Santa Clara, CA 95054, as evidenced by the assignment recorded at Reel 10254, Frame 0158.

II. RELATED APPEALS AND INTERFERENCES

No appeals or interferences are known which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 5-38 are pending. Claims 5-38 stand finally rejected under 35 U.S.C. §102(e) and 35 U.S.C. § 103(a) and are the subject of this appeal. A copy of claims 5-38, as on appeal, is included in the Appendix hereto.

IV. STATUS OF AMENDMENTS

Amendments to claims 30 and 32 were filed subsequent to the final rejection and entered by the Examiner in the Advisory Action of 12/22/2003. The Appendix hereto reflects the current state of the claims.

V. SUMMARY OF THE INVENTION

Appellant's claimed invention relates to a system and method to deliver personalized content to a small footprint device. This ability may be enabled by applications/services built on a lightweight containment framework (128 in Fig. 2) for a small footprint device executing in conjunction with network-based computing services. One embodiment of this containment framework is referred to as York 1.1. The containment framework enables module registration,

lookup, instance tracking, etc. Modules in the containment framework may be used by other modules as services. The containment framework may be dynamic, allowing modules to be registered and loaded as desired or needed. (Specification, page 3, lines 3-11.)

As described above, a containment framework for a small footprint device should be lightweight. The containment framework is able to function on a device with very little memory. For example, in one embodiment the containment framework may function on a device with only 300KB writeable memory and still leave enough memory space for several modules to operate. In addition, the containment framework may be responsive on devices with low processing power, such as small footprint devices with 16MHz-class chips. (Specification, page 3, lines 12-18.)

The containment framework may be based on common standards. For example, in one embodiment, the containment framework may be written in pure Java and may be fully compliant with and executed in the PersonalJava 3.0 application environment. PersonalJava is a Java application environment specifically designed for consumer devices for home, office, and mobile use. It comprises the Java virtual machine (JVM) (124 in Fig. 2) and a subset of the Java Application Programming Interface (API) (126 in Fig. 2), including core and optional APIs and class libraries. In addition, the PersonalJava API includes specific features required by consumer applications in resource-limited environments. It is noted that the containment framework may also be comprised in hardware ROM or be compiled into native code. (Specification, page 3, lines 19-28.)

Because the containment framework may be based on common standards, it may be ported easily to different device types and to devices made by different vendors, which greatly reduces time-to-market and development costs. The extendable architecture of the framework may also allow new modules to be introduced into the framework as needed or desired for different devices or services. The architecture may also allow for customizable and scaleable user interfaces. For example, the user interface component of an application may be swapped out as appropriate to the display type (106 in Fig. 1) for different devices. (Specification, page 4,

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lines 1-8.)

A system may comprise a set of core service modules available for other modules to use. These core services may include services such as the calendar, contact list, and bookmark services described in an example above. Together with such core services, the containment framework provides a complete architecture for running an integrated suite of applications and services on a small footprint device. For example, the Personal Applications suite available from Sun Microsystems, Inc. is built around one embodiment of the containment framework. The Personal Applications suite comprises an integrated set of compact, memory-efficient applications, including the Personal Applications Browser (148 in Fig. 3), the Personal Applications Email Client (150 in Fig. 3), and the Personal Organizer (152 in Fig. 3). (Specification, page 4, lines 9-17.)

Various services may be built on the above-described framework which run on a small footprint device and communicate with off-device services (132 in Fig. 2) to establish a system for gathering personal information from a small footprint device user, storing the information, and analyzing the information to send particular content to a small footprint device user. (Specification, page 4, lines 18-22.)

VI.   ISSUES

1.   Whether claims 5-18 and 21-38 are patentable under 35 U.S.C. § 102(e) over Rossmann (U.S. Patent No. 5,809,415).

2.   Whether claims 19 and 20 are patentable under 35 U.S.C. § 103(a) over Rossmann in view of Razavi et al. (U.S. Patent No. 6,253,122), hereinafter "Razavi."

VII.   GROUPING OF CLAIMS

Claims 5-7, 10, 11, 18, and 21 stand or fall together.

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Claims 8 and 9 stand or fall together.

Claims 12, 13, and 17 stand or fall together.

Claims 14-16 stand or fall together.

Claims 19 and 20 stand or fall together.

Claims 22-26 stand or fall together.

Claims 27 and 28 stand or fall together.

Claim 29 stands or falls alone.

Claims 30-33 stand or fall together.

Claims 34 and 35 stand or fall together.

Claim 36 stands or falls alone.

Claim 37 stands or falls alone.

Claim 38 stands or falls alone.

The claims are grouped as stated above for purposes of this appeal only. The reasons why each group of claims is believed to be separately patentable are explained below in the Argument.

VIII.   ARGUMENT

A.   Claims 5, 6, 7, 10, 11, 18, and 21

Claims 5-7, 10, 11, 18, and 21 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann (U.S. Patent No. 5,809,415) Appellant asserts that the rejection of claims 5-7, 10, 11, 18, and 21 is erroneous for at least the following reasons.

The cited art does not teach or suggest a method for a small footprint device communicating with a service accessible from the first network to send information to the service accessible from the first network, or the service accessible from the first network storing the information, as recited in claim 5. Rossmann teaches *a server processing a message from a client module* on the two-way data communication device and the server transmitting a response back to the two-way data communication device. The *communication device*, not the server, then stores the response in memory (col. 4, lines 30 – 47).

Furthermore, the cited art does not teach or suggest a service accessible from a second network receiving the information from the service accessible from the first network, the service accessible from the second network generating content based on the information, or the service accessible from the second network communicating with the small footprint device to send the content to the small footprint device, as recited in claim 5. Appellant notes that Rossmann does teach that a response to a message may be redirected (col. 11, lines 51 – 54). However, Appellant can find no language in Rossmann that teaches or suggests that such a redirected response may include the "stored information" of claim 5. Furthermore, even if, *arguendo*, the redirected response to a message is assumed to contain said information, *Rossmann does not teach or suggest that content may be generated from such a redirected response or communicated to the small footprint device.*

B.   Claims 8 and 9

Claims 8 and 9 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann. Claims 8 and 9 are separately patentable because the prior art does not suggest the limitations recited in these claims. Appellant asserts that the rejection of claims 8 and 9 is erroneous for at least the following reasons.

All the arguments given above in regard to claims 5-7, 10, 11, 18, and 21 apply. Regarding claims 8 and 9, furthermore, the Final Action argued that Rossmann discloses "the small footprint device rejecting the content" and "the small footprint device filtering the content" at figs. 8A and 8B and col. 25, line 5 to col. 26, line 59. Appellant respectfully disagrees. At the cited locations, Rossmann discloses methods for transmitting HTML data. Contrary to the Examiner's assertion, Appellant finds no reference to or suggestion of "rejecting" or "filtering" content at the cited locations in Rossmann.

C.   Claims 12, 13, and 17

Claims 12, 13, and 17 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann. Claims 12, 13, and 17 are separately patentable because the prior art does not

suggest the limitations recited in these claims. Appellant asserts that the rejection of claims 12, 13, and 17 is erroneous for at least the following reasons.

All the arguments given above in regard to claims 5-7, 10, 11, 18, and 21 apply. The Final Action argued that Rossmann discloses "wherein said sending information to the service accessible from the first network comprises sending information regarding a user of the small footprint device to the service accessible from the first network" and "wherein said service accessible from the second network generating content based on the information comprises the service accessible from the second network generating content based on the information regarding the user of the small footprint device" at fig. 4; col. 15, line 36 to col. 16, line 63; and col. 18, line 5 to col. 19, line 41. Appellant respectfully disagrees. At col. 15, line 36 to col. 16, line 63, Rossmann discloses the transmission of information by a service provider to a fax gateway, whereupon the fax gateway sends the information to a cellular telephone. However, Appellant respectfully submits that Rossmann does not teach or suggest sending information regarding a user of the small footprint device. At col. 18, line 5 to col. 19, line 41, Rossmann discloses the transmission of information from a cellular telephone to a service provider and the generation of a screen display at the cellular telephone. Again, Appellant respectfully submits that Rossmann does not teach or suggest generating content based on the information regarding a user of the small footprint device.

D.   Claims 14, 15, and 16

Claims 14-16 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann. Claims 14-16 are separately patentable because the prior art does not suggest the limitations recited in these claims. Appellant asserts that the rejection of claims 14-16 is erroneous for at least the following reasons.

All the arguments given above in regard to claims 5-7, 10, 11, 18, and 21 apply. The Final Action argued that Rossmann discloses the limitations of claim 14 at figs. 8A and 8B; col. 18, line 11 to col. 19, line 41; and col. 25, line 5 to col. 26, line 59. Appellant respectfully disagrees. At the cited locations, Rossmann discloses a user request for a stock quote and a user

request for a website address (URL). Therefore, Appellant respectfully submits that Rossmann does not teach or suggest "wherein said sending information regarding a user of the small footprint device to the service accessible from the first network comprises sending one or more of: demographic data regarding the user; information specifying buying habits of the user; information specifying web-browsing habits of the user; information specifying a geographic location of the user."

E.   Claims 19 and 20

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rossmann in view of Razavi et al. (U.S. Patent No. 6,253,122), hereinafter "Razavi." Claims 19 and 20 are separately patentable because the prior art does not suggest the limitations recited in these claims. Appellant asserts that the rejection of claims 19 and 20 is erroneous for at least the following reasons.

All the arguments given above in regard to claims 5-7, 10, 11, 18, and 21 apply. **Furthermore, Appellant asserts that the Examiner has not established a *prima facie* case of obviousness in regard to claims 19 and 20 for at least the following reasons.** The Final Action admits that Rossmann does not disclose the use of a Jini network. According to the Final Action, however, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a well known network such as Jini network of Razavi [into the computer system of Rossmann] to process data information because it would have provided more utilizations of the computer system in the network environment" (p. 8, paragraph 5). Appellant does not find any support for this statement in the cited reference. Thus, the Examiner's stated motivation does not appear to be based on the prior art, but instead in hindsight from Appellant's application. An obviousness claim that lacks evidence of a suggestion or motivation for one of ordinary skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis. *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000).

F.   Claims 22, 23, 24, and 25

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Claims 22-25 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann. Claims 22-25 are separately patentable because the prior art does not suggest the limitations recited in these claims. Appellant asserts that the rejection of claims 22-25 is erroneous for at least the following reasons.

All the arguments given above in regard to claims 5-7, 10, 11, 18, and 21 apply. Furthermore, although Rossmann does disclose the use of a computer server connected to a LAN, Rossmann does not teach or suggest "a first service executing on the LAN" and "a second service executing on the LAN." As illustrated by fig. 1, Rossmann depicts only one server coupled to a LAN. Appellant respectfully submits that Rossmann does not teach or suggest two separate services executing on a LAN, nor a second service executing on the LAN retrieving information stored by a first service executing on the LAN, as recited in claims 22 and 23.

G.   Claims 27 and 28

Claims 27 and 28 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann. Claims 27 and 28 are separately patentable because the prior art does not suggest the limitations recited in these claims. Appellant asserts that the rejection of claims 27 and 28 is erroneous for at least the following reasons.

All the arguments given above in regard to claims 5-7, 10, 11, 18, and 21 apply. Regarding claims 27 and 28, furthermore, the Final Action argued that Rossmann discloses "the small footprint device rejecting the content" and "the small footprint device filtering the content" at figs. 8A and 8B and col. 25, line 5 to col. 26, line 59. Appellant respectfully disagrees. At the cited locations, Rossmann discloses methods for transmitting HTML data. Contrary to the Examiner's assertion, Appellant finds no reference to or suggestion of "rejecting" or "filtering" content at the cited locations in Rossmann.

H.   Claim 29

Claim 29 stands rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann. Claim 29 is separately patentable because the prior art does not suggest the limitations recited in

this claim. Appellant asserts that the rejection of claim 29 is erroneous for at least the following reasons.

All the arguments given above in regard to claims 5-7, 10, 11, 18, and 21 apply. The Final Action argued that Rossmann discloses the limitations of claim 29 at figs. 8A and 8B; col. 18, line 11 to col. 19, line 41; and col. 25, line 5 to col. 26, line 59. Appellant respectfully disagrees. At the cited locations, Rossmann discloses a user request for a stock quote and a user request for a website address (URL). Therefore, Appellant respectfully submits that Rossmann does not teach or suggest "the second service generating personalized advertising content based on the information regarding the user of the small footprint device."

I. Claims 30, 31, 32, and 33

Claims 30-33 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann. Claims 30-33 are separately patentable because the prior art does not suggest the limitations recited in these claims. Appellant asserts that the rejection of claims 30-33 is erroneous for at least the following reasons.

For at least the reasons given in regard to claims 5-7, 10, 11, 18, and 21, the cited art fails to teach or suggest method for sending content to a small footprint device as recited in claim 30.

J. Claims 34 and 35

Claims 34 and 35 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann. Claims 34 and 35 are separately patentable because the prior art does not suggest the limitations recited in these claims. Appellant asserts that the rejection of claims 34 and 35 is erroneous for at least the following reasons.

All the arguments given above in regard to claims 5-7, 10, 11, 18, and 21 apply. Regarding claims 34 and 35, furthermore, the Final Action argued that Rossmann discloses "the small footprint device rejecting the content" and "the small footprint device filtering the content" at figs. 8A and 8B and col. 25, line 5 to col. 26, line 59. Appellant respectfully disagrees. At

the cited locations, Rossmann discloses methods for transmitting HTML data. Contrary to the Examiner's assertion, Appellant finds no reference to or suggestion of "rejecting" or "filtering" content at the cited locations in Rossmann.

K.   Claim 36

Claim 36 stands rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann. Claim 36 is separately patentable because the prior art does not suggest the limitations recited in this claim. Appellant asserts that the rejection of claim 36 is erroneous for at least the following reasons.

All the arguments given above in regard to claims 5-7, 10, 11, 18, and 21 apply. The Final Action argued that Rossmann discloses the limitations of claim 36 at figs. 8A and 8B; col. 18, line 11 to col. 19, line 41; and col. 25, line 5 to col. 26, line 59. Appellant respectfully disagrees. At the cited locations, Rossmann discloses a user request for a stock quote and a user request for a website address (URL). Therefore, Appellant respectfully submits that Rossmann does not teach or suggest "the first service generating personalized advertising content based on the information regarding the user of the small footprint device."

L.   Claim 37

Claim 37 stands rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann. Claim 37 is separately patentable because the prior art does not suggest the limitations recited in this claim. Appellant asserts that the rejection of claim 37 is erroneous for at least the following reasons.

For at least the reasons given in regard to claims 5-7, 10, 11, 18, and 21, the cited art fails to teach or suggest the limitations of the system as recited in claim 37.

M.   Claim 38

Claim 38 stands rejected under 35 U.S.C. § 102(e) as being unpatentable over Rossmann. Claim 38 is separately patentable because the prior art does not suggest the limitations recited in

this claim. Appellant asserts that the rejection of claim 38 is erroneous for at least the following reasons.

For at least the reasons given in regard to claims 5-7, 10, 11, 18, and 21, the cited art fails to teach or suggest the limitations of the system as recited in claim 38.

IX. CONCLUSION

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 5-38 was erroneous, and reversal of the Examiner's decision is respectfully requested.

A Fee Authorization form in the amount of $320.00 is enclosed to cover the fee for filing this Appeal Brief pursuant to 37 C.F.R. §1.17(b) (large entity). The Commissioner is also authorized to charge any extension fee or other fees which may be necessary to the same account number 501505/5181-29600/BNK.

Respectfully submitted,

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SUBMIT IN TRIPLICATE

X.   APPENDIX A

The claims on appeal are as follows.

5.   A method for sending content to a small footprint device, the method comprising:

the small footprint device connecting to a first network;

the small footprint device communicating with a service accessible from the first network to send information to the service accessible from the first network;

the service accessible from the first network storing the information;

a service accessible from a second network receiving the information from the service accessible from the first network;

the service accessible from the second network generating content based on the information; and

the service accessible from the second network communicating with the small footprint device to send the content to the small footprint device.

6.   The method of claim 5, further comprising:

the small footprint device displaying the content.

7.   The method of claim 6,

wherein the small footprint device executes a service for displaying dynamically generated content;

wherein said small footprint device displaying the content comprises the service for displaying dynamically generated content displaying the content.

8.   The method of claim 5, further comprising:

the small footprint device rejecting the content.

9.   The method of claim 5, further comprising:

the small footprint device filtering the content.

10. The method of claim 5,

wherein the first network is a local area network (LAN);

wherein the service accessible from the first network executes on a computer system in the first network.

11. The method of claim 5,

wherein the second network is a local area network (LAN);

wherein the service accessible from the second network executes on a computer system in the second network.

12. The method of claim 5,

wherein said sending information to the service accessible from the first network comprises sending information regarding a user of the small footprint device to the service accessible from the first network;

wherein said service accessible from the second network generating content based on the information comprises the service accessible from the second network generating content based on the information regarding the user of the small footprint device.

13. The method of claim 12,

wherein said service accessible from the second network generating content based on the information regarding the user of the small footprint device comprises the service accessible from the second network generating personalized advertising content based on the information regarding the user of the small footprint device.

14. The method of claim 12,

wherein said sending information regarding a user of the small footprint device to the service accessible from the first network comprises sending one or more of:

demographic data regarding the user;

information specifying buying habits of the user;

information specifying web-browsing habits of the user;

information specifying a geographic location of the user.

15.   The method of claim 12,

wherein said sending information regarding a user of the small footprint device to the service accessible from the first network comprises sending information specifying one or more items the user has purchased;

wherein said service accessible from the second network generating content based on the information comprises the service·accessible from the second network generating personalized advertising content based on the one or more items the user has purchased.

16.   The method of claim 5, further comprising:

the small footprint device communicating with the service accessible from the second network to send information specifying a store in which a user of the small footprint device is currently located;

wherein the service accessible from the second network generates the content based on the information and based on the store in which the user is currently located.

17.   The method of claim 5,

wherein said service accessible from the second network generating content based on the data comprises the service accessible from the second network generating advertising content based on the data.

18.   The method of claim 5,

wherein said small footprint device connecting to the first network comprises the small footprint device automatically connecting to the first network without a user requesting the small footprint device to connect to the first network.

19.   The method of claim 5,

wherein the first network is a Jini network.

20.   The method of claim 5,

wherein the second network is a Jini network.

21.   The method of claim 5,

wherein said small footprint device communicating with the service accessible from the first network to send information to the service accessible from the first network comprises a first service executing on the small footprint device communicating with the service accessible from the first network to send the information to the service accessible from the first network;

wherein said service accessible from the second network communicating with the small footprint device to send the content to the small footprint device comprises the service accessible from the second network communicating with a second service executing on the small footprint device to send the content to the small footprint device.

22.   A method for sending content to a small footprint device, the method comprising:

the small footprint device connecting to a local area network (LAN);

the small footprint device communicating with a first service executing on the LAN to send information to the first service;

the first service executing on the LAN storing the information on the LAN;

a second service executing on the LAN retrieving the information stored by the first service;

the second service executing on the LAN generating content based on the information; and

the second service executing on the LAN communicating with the small footprint device to send the content to the small footprint device.

23.   The method of claim 22,

wherein said first service executing on the LAN comprises a first service executing on a computer system in the LAN;

wherein said second service executing on the LAN comprises a second service executing on a computer system in the LAN.

24. The method of claim 22,

wherein said storing the information on the LAN comprises storing the information on a computer system in the LAN.

25. The method of claim 22,

wherein said storing the information on the LAN comprises storing the information on a file system in the LAN.

26. The method of claim 22, further comprising:

the small footprint device displaying the content.

27. The method of claim 22, further comprising:

the small footprint device rejecting the content.

28. The method of claim 22, further comprising:

the small footprint device filtering the content.

29. The method of claim 22,

wherein said sending information to the first service comprises sending information regarding a user of the small footprint device to the first service;

wherein said second service generating content based on the information comprises the second service generating personalized advertising content based on the information regarding the user of the small footprint device.

30. A method for sending content to a small footprint device, the method comprising:

the small footprint device connecting to a local area network (LAN);

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the small footprint device communicating with a first service executing on the LAN to send information to the first service;

the first service executing on the LAN storing the information received from the small footprint device;

the first service executing on the LAN generating content based on the information; and

the first service executing on the LAN communicating with the small footprint device to send the content to the small footprint device.

31. The method of claim 30,

wherein said first service executing on the LAN comprises a first service executing on a computer system in the LAN.

32. The method of claim 30,

wherein said first service executing on the LAN generating content based on the information comprises the first service executing on the LAN retrieving the stored information at a later time and generating the content based on the information.

33. The method of claim 30, further comprising:

the small footprint device displaying the content.

34. The method of claim 30, further comprising:

the small footprint device rejecting the content.

35. The method of claim 30, further comprising:

the small footprint device filtering the content.

36. The method of claim 30,

wherein said sending information to the first service comprises sending information regarding a user of the small footprint device to the first service;

wherein said first service generating content based on the information comprises the first service generating personalized advertising content based on the information regarding the user of the small footprint device.

37.   A system comprising:

a small footprint device;

a first network, wherein the first network includes a first service operable to communicate with the small footprint device; and

a second network, wherein the second network includes a second service operable to communicate with the small footprint device;

wherein the small footprint device is operable to connect to the first network to send information to the first service;

wherein the first service is operable to store the information;

wherein the small footprint device is operable to connect to the second network;

wherein the second service is operable to retrieve the information stored by the first service and generate content based on the information;

wherein the second service is operable to send the content to the small footprint device; and

wherein the small footprint device is operable to display the content.

38.   A system comprising:

a small footprint device; and

a local area network (LAN), wherein the LAN includes a first service operable to communicate with the small footprint device and a second service operable to communicate with the small footprint device;

wherein the small footprint device is operable to connect to the LAN to send information to the first service;

wherein the first service is operable to store the information on the LAN;

wherein the second service is operable to retrieve the information stored by the first service and generate content based on the information;

wherein the second service is operable to send the content to the small footprint device; and

wherein the small footprint device is operable to display the content.